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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,265

06/14/2007

Astrid Netz

065571-0084

6095

38939 7590 08/18/2010

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EXAMINER

POWERS, FIONA

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

08/18/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/590,265	<b>Applicant(s)</b> NETZ ET AL.	
	<b>Examiner</b> Fiona T. Powers	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/18/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

Claims 1 to 11 and d13 to 22 are pending in the application.

Receipt is acknowledged of the preliminary amendment filed August 18, 2006, which has been entered in the file.

***Election/Restrictions***

Applicant's election without traverse of Group I (claims 1 to 11 and 13 where Q is Q1 where E is S) and W is W1) in the reply filed on June 25, 2010 is acknowledged.

Claims 14 to 22 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 25, 2010.

***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on August 18, 2006 has been considered. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The references which are crossed out on PTO 1449 are not of record in the file.

***Specification***

The disclosure is objected to because of the following informalities: the specification contains underlining and formatting notes. Note pages 43 to 50, for example, of the specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 to 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. In claims 1 and 2, the phrase "general formula" renders the claims indefinite because it implies that compounds not embraced by the formula are being claimed. It is suggested that the phrase be change to "of the formula".

2. Throughout the claims periods are used within the claims. See for example, the 3<sup>rd</sup> and 4<sup>th</sup> lines from the bottom of page 9 of claim 1. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See MPEP 608.01(m).

3. In claim 1, page 3, 2<sup>nd</sup> line from the bottom, "hetaryl" (2<sup>nd</sup> occurrence) is misspelled.

4. In claims 8, 9 and 10, the boxes around the formulae represented by Q or R<sup>4</sup> and R<sup>5</sup> should be deleted.

5. Claim 5 does not end with a period.

6. Claim 10, line 3 refers to "7.)" but "7.)" is not listed in the claim. "7.)" should be changed to "6)".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

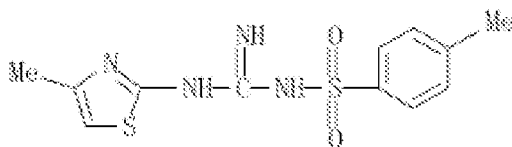
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Registry No. 260443-24-1, entered into Registry file on March 31, 2000, cited.

Registry No. 260443-24-1 is the claimed compound of the formula I wherein Q=Q1 where E is S and one of R<sup>4</sup> and R<sup>5</sup> is hydrogen and the other is methyl; R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> are hydrogen; Z=Z1 where a and c are 0, b is 1, and V<sub>z</sub> is -SO<sub>2</sub>-; and W=W1 where A is methyl and B and R<sub>w</sub><sup>1</sup> are hydrogen. Note the formula shown below.

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RN 260443-24-1 REGISTRY  
ED Entered STN: 31 Mar 2000  
CN Benzenesulfonamide, N-[imino[(4-methyl-2-thiazolyl)amino]methyl]-4-methyl-  
(CA INDEX NAME)  
OTHER CA INDEX NAMES:  
CN Benzenesulfonamide, N-[amino[(4-methyl-2-thiazolyl)amino]methylene]-4-  
methyl- (9CI)  
MF C12 H14 N4 O2 S2  
SR CAS Client Services

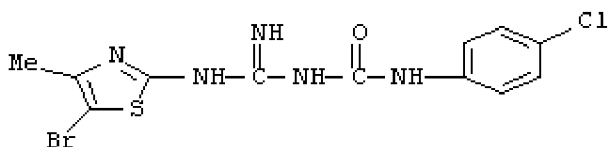


Claims 1-3, 6, 7, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Registry No. 672884-90-1, entered into Registry file on April 8, 2004, cited.

Registry No. 672884-90-1 is the claimed compound of the formula I wherein Q=Q1 where E is S and one of R<sup>4</sup> and R<sup>5</sup> is methyl and the other is bromo; R<sup>1</sup>, R<sup>2</sup> and R<sup>3</sup> are hydrogen; Z=Z1 where a and c are 0, b is 1, and V<sub>z</sub> is -CO-NH-; and W=W1 where A is chloro and B and R<sub>w</sub><sup>1</sup> are hydrogen. Note the formula shown below.

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RN 672884-90-1 REGISTRY  
ED Entered STN: 08 Apr 2004  
CN Urea, N-[[ (5-bromo-4-methyl-2-thiazolyl) amino] iminomethyl] -N'-(4-chlorophenyl)- (CA INDEX NAME)  
MF C12 H11 Br Cl N5 O S  
SR Chemical Library  
Supplier: Maybridge plc  
LC STN Files: CHEMCATS



\*\*PROPERTY DATA AVAILABLE IN THE 'PROP' FORMAT\*\*

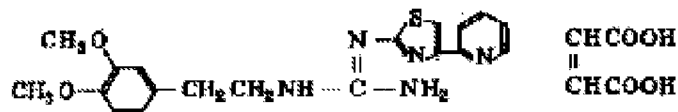
Claims 1, 2, 4, 5, 8, 9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Number 59-36674, cited.

The reference discloses the claimed compound and composition of the formula I wherein Q=Q1 where E=S; one of R<sup>4</sup> and R<sup>5</sup> is hydrogen and the other is pyridyl or furyl; W=W1 where A and B are methoxy and R<sub>w</sub><sup>1</sup> is hydrogen; R<sup>1</sup>-R<sup>3</sup> are hydrogen; and Z



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is  $-\text{CH}_2\text{CH}_2-$ . Note the compound Example 10 on page 7 which is



shown below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Number 59-36674 and Chemical Abstracts, 101:7147, 1984, cited.

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

The reference discloses structurally similar compounds that are useful as antisecretory agents (Abstract). The compounds of the reference are structurally similar to the claimed compounds of the formula I wherein  $\text{Q}=\text{Q1}$  where E is S and one of  $\text{R}^4$  and  $\text{R}^5$  is hydrogen and the other is chosen from 7.) pyridyl or furyl;  $\text{R}^1$ ,  $\text{R}^2$  and  $\text{R}^3$  are hydrogen;  $\text{Z}=\text{Z1}$  where a and c are 0, b is 1, and Z is optionally substituted alkyl or  $-\text{CH}_2\text{CH}_2\text{O}-$ ; and  $\text{W}=\text{W1}$  where A

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and B are methoxy and  $R_w^1$  is hydrogen. Note the compounds of Examples 6-11, for example.

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The compounds of the reference differ from those claimed in that a hydrogen atom has been substituted for a methyl group on the phenyl ring that corresponds to W1 of the present invention or a methoxy group has been substituted for an ethoxy group for the group that corresponds to A of the present invention.

*Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)*

It has been held that it is obvious to substitute a hydrogen atom for an alkyl group and that homologs are obvious over one another. See *In re Wood*, 199 USPQ 137 and *In re Lincoln*, 53 USPQ 40, for example. One of ordinary skill in the art would have been motivated to make the claimed compounds with the expectation that additional compounds useful as antisecretory agents would be obtained.

***Allowable Subject Matter***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can

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normally be reached on Mon - Thurs 6:15 am - 2:45 pm (in the office) and Fri 7:00 am - 5:30 pm (telework day).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/  
Primary Examiner, Art Unit  
1626

ftp  
August 16, 2010